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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,415	02/14/2001	Naruhiko Mashita	203162US0	5959

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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/13/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,415

Applicant(s)

MASHITA ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 22-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit 1711

Applicant's election with traverse of Group I, claims 1-21 and the species of isoprene containing thermoplastic elastomers, polyolefinic resin species A and polypropylene as an ultimate single disclosed species of polyolefinic resin species B in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the claims of the Group II invention depend directly on the claims of Group I and that the products of Group I are made by the process of Group II. Also it is alleged that no undue burden of search exists. This is not found persuasive because the fact that the Group II claims depend from the Group I claims means that the Group II claims must contain all the limitations of the Group I claims. However the opposite is not true and in the instant case the Group I claims contain no process limitations found in the Group II claims. With regard to applicants' allegation of undue burden of search, the search for the groups of inventions are not co-extensive and fall into different classes and subclasses as set out in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claim 14 is rejected under 35 U.S.C. § 101 because this claim is drawn to a use and is therefore non-statutory.

Claims 13, 14, 20 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

Art Unit 1711

point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 13 and 14 recite a gasket integrated with a metal in the preamble and yet recite that the gasket is integrated with the metallic cover or metallic frame or is used for a hard disk apparatus and therefore it is unclear whether a gasket is being claimed or whether the claims are limited to an article containing a gasket in combination with a metallic cover or metallic frame or as part of a hard disk apparatus. With regard to claims 20 and 21, these claims recite a composite molded article and yet recite that a cover is present and it is therefore unclear as to whether these claims are limited as to gasket/cover combinations or if merely a gasket is being claimed.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 8-12, 15 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmons et al. (USP 5,869,555).

Art Unit 1711

Simmons et al. discloses a composition that contains a block copolymer having a molecular weight of greater than 200,000 including Kraton G1651 (column 5 lines 36-54). The high molecular weight block copolymer is used in combination with the lower molecular weight grafted block copolymer at column 5 lines 55-60 and in the Examples. Aliphatic oils may be added at column 7 lines 5-10. Applicants' and patentees' compositions recite similar ingredients and therefore applicants' and patentees' characteristics are assumed to be similar or identical.

Simmons et al. discloses no specific examples having a combination of the materials required by the claims and no examples of lamination to metals are disclosed.

Borba (5,384,994) discloses at column 4 lines 63-68 that metal may be laminated to a polystyrene containing composition in order to confer fire resistance.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to provide a composition with applicants' combination of materials since Bank discloses that such composition which may contain each of applicants' materials and in the expectation of adequate results absent any showing of surprising or unexpected results.

With regard to lamination to a metal of applicants' composition, it would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to

Art Unit 1711

laminate the composition of Bank to a metal sheet as taught by Borba in order to confer the advantage of fire resistance absent any showing of surprising or unexpected results.

Claims 1-5, 8-12, 15 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bank et al. (USP 6,239,217) in view of Borba (USP 5,384,994), cited above.

Bank et al. disclose a composition containing 5-30 parts of a polyolefin, 1-10 parts of a block copolymer and 0-25 parts of another block copolymer "B" (Abstract). The polyolefin may be maleic anhydride grafted at column 2 lines 15-18. Note column 14 lines 35-47 for use in the Examples of an aliphatic oil and the block copolymer Kraton G1651, a block copolymer having a styrene content of 32% and a molecular weight of 270,000. Applicants' and patentees' compositions are similar and therefore presumed to have similar or identical characteristics.

No examples are disclosed in which the polyolefin is grafted and lamination of the composition to a metal is not disclosed.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to graft the polyolefin of Bank et al. since Bank et al. discloses that the polyolefin may be grafted and in the expectation of adequate results absent any showing of surprising or unexpected results.

With regard to lamination of metal, it would have been obvious to a practitioner having ordinary skill in the art at the

Serial No. 09/784,415

-6-

Art Unit 1711

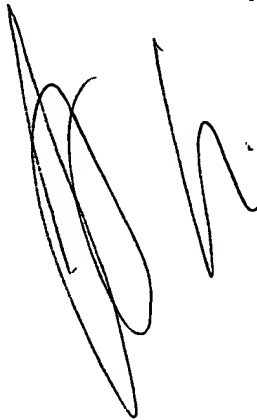
time of the invention to laminate the composition of Bank et al. to metal as taught by Borba in order to confer the advantage of fire resistance absent any showing of surprising or unexpected results.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

January 12, 2003

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to be 'J. Mullis', written over the printed name and title.